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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,051	01/15/2000	MICHAEL J. PICCIALLO	73348.00008	1136
29880                      7590                      07/03/2012 FOX ROTHSCHILD LLP PRINCETON PIKE CORPORATE CENTER 997 LENOX DRIVE BLDG. #3 LAWRENCEVILLE, NJ 08648				
EXAMINER				
KUCAB, JAMIE R				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
07/03/2012		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[ipdocket@foxrothschild.com](mailto:ipdocket@foxrothschild.com)

**Office Action Summary****Application No.**

09/478,051

**Applicant(s)**

PICCIALLO, MICHAEL J.

**Examiner**

Jamie Kucab

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2012.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 75, 78-83, 85, 87, 99, 111, 112 and 114 is/are pending in the application.
- 5a) Of the above claim(s) 99, 111 and 112 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 75, 78-83, 85, 87, and 114 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 297)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicant's response filed June 6, 2012 is acknowledged.
2. Claims 75, 78-83, 85, 87, 99, 111, 112, and 114 are pending in the application.
3. Claims 99, 111, and 112 are withdrawn from consideration.
4. Claims 75, 78-83, 85, 87, and 114 are examined below.

### ***Priority***

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. §119(e) or under 35 U.S.C. §§ 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 as follows:
  6. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. §112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).
  7. The disclosure of the prior-filed application, Application No. 08/585,173, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. 08/585,173 fails to provide the necessary support for such limitations as "computer-based," "establishing computer

transfers of allowance money," "preventing or allowing debit card access to said third party account using information received from said fund depositor," and "said transfers to occur periodically and automatically under computer processor control" of the independent claim 75.

***Claim Rejections - 35 USC § 112, Second Paragraph***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 75, 78-83, 85, 87, and 114 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

10. Regarding claim 75, Applicant's recitation "... allowing debit card access to said third party account using information received from said fund depositor" would have been unclear to a person having ordinary skill in the art at the time of the invention. It is unclear whether this recitation requires a step to be performed. It is the Examiner's position that unless an actor is preventing someone from doing something, then under the broadest reasonable interpretation, that actor is allowing that someone to do that something. However, it appears to be Applicant's intent that this recitation requires the performance of a method step.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 75, 78-83, 85, 87, and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Fleming (US Patent 5,953,710, hereafter, "Fleming") in view of Langhans et al. (US Patent 5,500,513, hereafter "Langhans") or Gray (Ref. V on the PTO form 892 mailed June 8, 2005) in view of Examiner's Official Notice and further in view of Langhans.

13. Regarding claim 75, Fleming discloses a computer-based method comprising:

- a. creating a third party account ("a child's credit card account," Abstract) using information received from a fund depositor ("linked to a parent's credit or debit card account," Abstract);
- b. establishing computer transfers of allowance money into said third party account from said fund depositor account, said transfers to occur periodically and automatically under computer processor control ("When the parent selected allowances, they would be prompted by the Bank Telecom Interface 62 to enter the allowance amount and the periodic interval of the allowance, such as weekly." C14 L55-58); and
- c. supplying to said fund depositor information on payees ("Merchant/Info," Fig. 2A) and corresponding payment amounts ("Amount," Fig. 2A) for said third

party account (see Fig. 2A showing that child transactions are a subset of the data provided on the Parent Statement List 56).

14. Regarding claim 75, Gray discloses a computer-based method comprising:
  - d. creating a third party account using information received ("The accounts are set up," pg. 1);
  - e. establishing computer transfers of allowance money into said third party account from said fund depositor account, said transfers to occur periodically and automatically under computer processor control ("The accounts are set up to allow automatic deposit" pg. 1);
  - f. supplying information on payees and corresponding payment amounts for said third party account ("bank statement," pg. 1).
15. Gray fails to explicitly disclose that the account is created using information received from the fund depositor (ie, parent) and that the information on payees and payment amounts is supplied to that fund depositor.
16. However, the Examiner takes Official Notice that it is old and well known in the art that parents do things for their children and read their correspondence because a parent often has incentives for doing so and it is often societally acceptable for a parent to do so.
17. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Gray to include the parental involvement of Examiner's Official Notice because all the claimed steps were known in the prior art and one skilled in the art could have combined the steps as claimed by known methods with

no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

18. Regarding claims 75, 78-81, 87, 102-105, and 110, neither Fleming nor Gray/O.N. explicitly disclose the steps of:

- a. preventing or allowing debit card access to said third party account using information received from said fund depositor;
- b. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer;
- c. verifying a fund transfer requested from said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased;
- d. wherein said goods or services comprise books, computer software, food, lodging or entertainment;
- e. wherein said limit is a periodic limit; and
- f. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco.

19. However, Langhans teaches:

- g. preventing or allowing debit card access to said third party account using information received from said fund depositor ("A test 126 determines whether

the Standard Industrial Classification (SIC) code of the merchant is acceptable for the account. If it is not, the request will be declined." C7 L55-58); and

h. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer ("The present invention also allows a company to group merchant category codes in order to limit purchases to those merchant types which would be needed by a particular department or individual." C2 L37-40);

i. verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased ("A test 126 determines whether the Standard Industrial Classification (SIC) code of the merchant is acceptable for the account. If it is not, the request will be declined." C7 L55-58);

j. wherein said goods or services comprise books, computer software, food, lodging or entertainment ("a salesperson could be allowed a velocity checking limit for the category of hotels at a high frequency level, while an accounting clerk with no reason to travel could be allocated a lower velocity level, or allocated no authorization for hotels at all." C2 L12-17);

k. wherein said limit is a periodic limit ("Test 138 allows a spending limit to be applied over a company-defined cycle, such as a monthly cycle or other billing cycle." C8 L9-11); and



- I. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco ("control cash advances," C13 L27-28).
20. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the methods of Fleming and Gray/O.N. to include the preventing or allowing step, limiting step, verifying step, merchant categories, periodic limit, and controlling cash advances of Langhans in order to achieve the predictable result of giving the parent greater flexibility in the control of the child's spending.
21. Regarding claim 82, Fleming further discloses wherein said stored information on payees and corresponding payment amounts for said third party account is automatically supplied to said fund depositor ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).
22. Regarding claim 83, Fleming further discloses wherein said supplying step is performed periodically ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).
23. Regarding claim 85, Fleming further discloses wherein said money is transferred weekly or monthly ("When the parent selected allowances, they would be prompted by the Bank Telecom Interface 62 to enter the allowance amount and the periodic interval of the allowance, such as weekly," C14 L55-58).

24. Regarding claims 79 and 114, the combination Fleming/Langhans or Gray/O.N./Langhans teaches permitting purchases from a computer software store or a bookstore in that neither reference discloses preventing such purchases.

### ***Response to Arguments***

25. Applicant's arguments filed June 29, 2011 have been fully considered, but they are only partially persuasive.

26. The §112, 1<sup>st</sup> paragraph rejection of claim 87 has been withdrawn in response to Applicant's amendments.

27. The §112, 1<sup>st</sup> paragraph rejection of claim 79 has been withdrawn in response to Applicant's argument.

28. The §112, 2<sup>nd</sup> paragraph rejections of claim 78 have been withdrawn in response to Applicant's amendments.

29. Applicant's arguments regarding the prior art rejections of the previous Office action are moot in view of the new grounds of rejection.

30. Regarding the double patenting rejection, this rejection is withdrawn in response to the terminal disclaimer filed June 5, 2012 and approved June 6, 2012.

### ***Conclusion***

31. Applicant's amendment filed June 5, 2012 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

33. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

34. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

Furthermore, suggestions or examples of claim language provided by the Examiner are just that--suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not* been addressed with

respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

35. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

36. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jay Kramer, can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jamie Kucab/  
Primary Examiner, Art Unit 3621